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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,369	12/10/2004	Francis Pinault	Q84992	3960
23373 7590 10/04/2007 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER NICKERSON, JEFFREY L	
			PART UNIT 2109	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/517,369

Applicant(s)

PINAULT ET AL.

Examiner

Jeffrey Nickerson

Art Unit

2109

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10 December 2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to Application No. 10/517,369 filed on 10 December 2004. The preliminary amendment, which provides change to claims 11 and 22, and also cancels claims 23-27, is hereby acknowledged. Claims 1-22 have been examined.

Information Disclosure Statement

2. The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been

considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

3. The information disclosure statement filed 10 December 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Specification

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The abstract of the disclosure is objected to because it contains the phrase "The invention concerns" in the first sentence of the abstract. This phrase falls into the category of implied phraseology and should be removed. The abstract also contains the phrases "The server comprises control *means*", "set up on *said* first channel", and "as to provide *said* terminal" in the second sentence of the abstract. These phrases fall into the category of legal phraseology and should be corrected appropriately.

Correction is required. See MPEP § 608.01(b).

6. The disclosure is objected to because of the following informalities: confusing wording, incorrect grammar, and misspellings.

Page 4, lines 21-26 of the applicant submitted specification (Pre-Grant publication: [0014]) is one, long, run-on sentence that is confusing to understand and could be easily corrected either by splitting the sentence into multiple sentences or by inserting commas.

Appropriate correction is required.

Art Unit: 2109

Page 8, line 15 of the applicant submitted specification (Pre-Grant publication: [0038]) contains the acronym "PWTAI" which seems to be defined appropriately. However, Figure 2 and Page 8, line 25 (Pre-Grant publication: [0042]) both use the acronym "PWTA" in the stead of the above acronym. The specification and drawings should be consistent in their terminology. Either the specification should be amended to list the acronym as "PWTA" in every occasion, or the specification and drawings should be amended to list the acronym as "PWTAI" in every occasion.

Appropriate correction is required.

Page 9, line 3 of the applicant submitted specification (Pre-Grant publication: [0044]) contains the identifier "WEA-UA", when it should be "WAE-UA."

Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Mani (US 2002/0188725 A1).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Mani teaches a communication server (Mani: Figure 4, 418; Multimedia softswitch) for making services (Mani: third party applications, services) offered by a private second communication network (Mani: Figure 5, item 506) available to terminals (Mani: Figure 5, item 516; multimedia devices, terminals) connected to a first communication network (Mani: Figure 5, item 502: PSN/CSN, public telecommunications network)

and able to exchange signaling data on a first transmission channel (Mani: Figure 2, item 204; [0021] specifies the use of SIP and SS7) and voice data on a second transmission channel (Mani: Figure 2, item 206) simultaneously in accordance with the selected protocol (Mani: [0023] specify the use of various voice and audio related protocols such as RTP)

which server is characterized in that it comprises control means (Mani: Figure 3, items 302 and 306; call/connection session control engine in combination with access

engine) adapted to send to a terminal connected to the first network, (Mani: Figure 5, item 516 connected to item 502),

on said first channel and as a function of a selected criterion (Mani: abstract specifies indication from user), configuration data to enable said terminal to set up a connection with said server on the first channel (Mani: [0021] specifies that SIP and SS7 can be used as session control protocols, which inherently setup connections) during a voice connection on said second channel (Mani: abstract specifies an access service application running; [0026] specifies that the access application could include voice recognition technology; [0041] specifies further that the access application could use audio or video capture from the terminal),

so as to make at least some of said services offered by said second network (Mani: abstract specifies eventually accessing controlled services) available to said terminal during said voice connection. (Mani: [0044] specifies that further access interrogation, and thus a voice connection, may occur during the accessing of a service)

Regarding claim 2, Mani teaches wherein the control means are adapted to send configuration data to a terminal when said terminal has set up a connection with said server (Mani: [0021] specifies that SIP and SS7 can be used as session control protocols, which inherently setup connections) using a selected primary identifier, setting up said connection constituting said selected criterion. (Mani: [0012] specifies collecting one or more multimedia responses in order to verify the user and allow access to the network resource)

Regarding claim 3, Mani teaches wherein said control means are adapted to effect an identification procedure before sending said configuration data. (Mani: [0012] specifies access is granted to the service only if the user is verified)

Regarding claim 4, Mani teaches wherein the server comprises

a memory (database) in which secondary identifiers are stored (Mani: [0012] specifies a user access profile; [0010] indicates the access profile can hold more than one identifier to verify against)

and in that said control means are adapted to send to said terminal identification data which (Mani: abstract specifies invoking an access service application),

once installed in said terminal, enables the automatic sending to said server (Mani: [0049] specifies that interrogation can occur without user interaction)

of at least one secondary identifier stored in a memory of said terminal (Mani: [0012] specifies more than one multimedia response used for verification)

and then to compare the received secondary identifier with identifiers stored in said memory and then to send said configuration data to said terminal if the identifiers are identical. (Mani: [0012] specifies allowing access only after one or more identifiers are verified against the database that contains user profiles)

Art Unit: 2109

Regarding claim 5, Mani teaches wherein said control means are adapted to send security data (interrogation) to the terminal after said configuration data. (Mani: [0044] specifies that interrogations can occur after the network resource is being accessed)

Regarding claim 6, Mani teaches wherein the said secondary identifier represents the user of said terminal. (Mani: [0012] specifies live picture IDs and speech samples)

Regarding claim 7, Mani teaches wherein the said configuration data and/or said identification data constitutes a script or an applet. (Mani: abstract specifies the identification data is interrogated and processed with an access service application)

Regarding claim 8, Mani teaches wherein said configuration data is adapted, in the event of activation by the user of the terminal, (Mani: abstract specifies the user indicates)

to prompt (interrogate) said user to provide at least one tertiary identifier and to send a registration request (access attempt) containing at least said tertiary identifier to said control means (Mani: [0039] specifies different types of authentication techniques) on the first channel, (Mani: [0035] specifies that SS7 capabilities are used, which inherently pass data along the signaling channel, such as an IMSI)

in that said memory stores said primary identifiers in corresponding relationship to at least one tertiary identifier, and in that said control means are adapted, on the receipt of a registration request, to send to said configuration data a request for the

Art Unit: 2109

transmission of at least one primary identifier associated with said terminal, and then, on reception of said primary identifier, to compare the primary identifier and the tertiary identifier previously received to the identifiers stored in said memory in order to authorize or refuse said registration as a function of the result of this comparison.

(Mani: [0037]-[0042] specify a database cluster that holds profile information with multiple identifiers and the possibility of cascading interrogation to receive multiple levels of authentication, where the database server could be available to both the private and public networks and the interrogation responses are verified against the user access profiles)

Regarding claim 9, Mani teaches wherein

said configuration data is adapted, in the event of reception of a call request message (access attempt) from the first network by said terminal (Mani: Figure 6A, item 602 specifies the user attempting to access a network resource)

to extract certain information from said message and to send that information to said control means via said first channel, (Mani: [0040] specifies that the access engine is launched; [0029] specifies multiple applications may require authentication and using SS7 platforms; This implies that the control and access engine have to extract and identify which service is trying to be accessed from the access attempt)

and in that said control means are adapted, on receipt of said information, to process it as a function of its content and then send to said terminal on said first channel a message selected as a function of the processing applied and the information

Art Unit: 2109

received. (Mani: [0030] and [0041] specifies setting up the connection to return a message that interrogates the user; [0042] specifies multiple interrogation schemes may be performed as a function of which service is being accessed)

Regarding claim 10, Mani teaches wherein

said configuration data is adapted, after the terminal has been registered (allowed access) and in the event of an attempt by said terminal to call (access attempt) a remote terminal (network resource) (Mani: [0010] specifies users having user access profiles implying they're registered; [0042] specifies that multiple layers of interrogation for access requests may be employed, implying an access request for a higher level security network resource could occur even once a user is allowed access to a lower level of security)

to inhibit access to the first network and to send information including at least the primary identifier of the remote terminal to said control means on said first channel, (Mani: [0047] specifies that the access control can be utilized to grant access to the public network)

and in that said control means are adapted, on receipt of said information, to process it as a function of its content (Mani: [0042] specifies multiple interrogation schemes may be performed as a function of which service is being accessed)

and then to send to said terminal on said first channel a message selected as a function of the processing applied and the information received and comprising at least one call authorization or prohibition (Mani: [0042] specifies multiple interrogation request

Art Unit: 2109

sequences that require authorization for each response, implying the user is notified if there is an incorrect response)

and information to be displayed on the screen of said terminal (Mani: [0008] specifies the user terminal is a multimedia appliance; [0020] specifies multiple possibilities of multimedia, such as presentation of text)

so that on reception of said message said configuration data either removes the inhibition on access to the first network with a view to setting up the call or prohibits the call. (Mani: [0042] specifies that once the interrogation sequence is completed successfully it grants access to the user otherwise it does not)

Regarding claim 11, this server claim comprises limitations substantially similar to that of claim 9 and the same rationale of rejection is used, where applicable. And wherein said control means are adapted to process the information received from said terminal after registering the terminal. (Mani: [0044] specifies that additional interrogation and processing of those interrogations may occur after the original access is granted)

Regarding claim 12, this method claim comprises limitations substantially similar to that of claim 1 and the same rationale of rejection is used, where applicable.

Regarding claim 13, this method claim comprises limitations substantially similar to that of claim 2 and the same rationale of rejection is used, where applicable.

Art Unit: 2109

Regarding claim 14, this method claim comprises limitations substantially similar to that of claim 3 and the same rationale of rejection is used, where applicable.

Regarding claim 15, this method claim comprises limitations substantially similar to that of claim 4 and the same rationale of rejection is used, where applicable.

Regarding claim 16, this method claim comprises limitations substantially similar to that of claim 5 and the same rationale of rejection is used, where applicable.

Regarding claim 17, this method claim comprises limitations substantially similar to that of claim 6 and the same rationale of rejection is used, where applicable.

Regarding claim 18, this method claim comprises limitations substantially similar to that of claim 7 and the same rationale of rejection is used, where applicable.

Regarding claim 19, this method claim comprises limitations substantially similar to that of claim 8 and the same rationale of rejection is used, where applicable.

Regarding claim 20, this method claim comprises limitations substantially similar to that of claim 9 and the same rationale of rejection is used, where applicable.

Art Unit: 2109

Regarding claim 21, this method claim comprises limitations substantially similar to that of claim 10 and the same rationale of rejection is used, where applicable.

Regarding claim 22, this method claim comprises limitations substantially similar to that of claim 11 and the same rationale of rejection is used, where applicable.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Beresin (US 6,788,667 B1) discloses a system and method for handling audio service requests between mobile devices and the Internet.
- b. Bleuse et al (US 6,324,579 B1) discloses a system and method for personalizing Internet access from a mobile device through an Intelligent Network.
- c. Chow et al (US 2002/0191557 A1) discloses a system for connecting terminal devices connected to public networks through a public packet network to a home or business network and controlling said terminal devices remotely via devices on the home or business network.
- d. Dorenbosch et al (US 2002/0138622 A1) discloses a method and system for pushing messages from a public network to a private telecommunications

network and then onto the terminal devices via a NAT that converts the public address to the private address (IP to IMSI).

e. Gruner et al (US 2002/0128003 A1) discloses a system to provide private network services to a public or private network's mobile terminal devices via a gateway.

f. Hagen (US 2002/0075844 A1) discloses a system and method of mobile terminal devices accessing public networks through private network access points via a network access server (NAS) that performs registration and monitoring of various statistics of the mobile users.

g. Kermarec et al (US 2003/0110268 A1) discloses a method of providing VPN services through a public shared network.

h. Monroe et al (US 2002/0136173 A1) discloses a method for communicating message notifications from terminal devices across a private and then public network.

i. Schein et al (US 6,226,623 B1) discloses a system and method for providing financial services from a private network to remote, public terminals using various access schemes.

j. Vergnaud et al (US 2004/0073674 A1) discloses a server for allocating resources to terminals across multiple networks including the Internet and PSTN and determining access to various content and data.

Art Unit: 2109

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Nickerson whose telephone number is 571-270-3631. The examiner can normally be reached on M-Th, 8:30-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beatriz Prieto can be reached on 571-272-3902. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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September 25, 2007


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